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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,451	08/14/2001	Akihiko Okada	Q65793	8140

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EXAMINER

THAI, CANG G

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,451

Applicant(s)

OKADA, AKIHIKO

Examiner

Cang G. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 14, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date August 14, 2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 2000-253506, filed on August 24, 2000.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on August 14, 2001, is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject

matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, Claim 13 does not require any technology. The recited steps of sales promoting does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea of how to promote sales.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent No. 5,937,158 (URANAKA).

As for claim 2, URANAKA discloses a computer peripheral sales promoting system comprising:

- a) a service status detecting means for detecting a service status of a computer peripheral and customer product information storing means for storing specifications information of said computer peripheral and user information of said computer peripheral and also for consecutively

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updating and storing a service status detected by said service status detecting means is provided to said computer peripheral {Column 25, Lines 15-19, wherein this reads over "the central control means of the retrieval server retrieves the information providing the server having the information, which the information retriever seeks, among the information providing server group using the server"}; and

- b) a sales promoting terminal for making access to said customer product information storing means to thereby read out said specifications information, said user information, and service status is arranged in a network to which said computer peripheral is connected {Column 9, Lines 20-22, wherein this reads over "the user obtains the restaurant guide DVD by buying it at a bookshop or by mail order sale or at the distribution form a restaurant guide service provider"}.

As for claim 1, URANAKA discloses a computer peripheral sales promoting system comprising:

- a) a service status detecting means for detecting a service status of a computer peripheral and customer product information storing means for storing specifications information of said computer peripheral and user information which specifies a user of said computer peripheral and also for consecutively updating and storing a service status detected by said service status detecting means are provided in a computer which serves as an upper-level system for said computer peripheral {Column 17, Lines

26-31, wherein this reads over “an electronic catalog DVD, which contains data relating to the commodity such as specifications, external appearance, price, commodity code, etc. of the commodity to be sold, program used for certification of the user, and purchase history information storage area”). It appears that the DVD would read over the service status through purchase history by the user.

- b) a sales promoting terminal for making access to said customer product information storing means to thereby read out said specifications information, said user information, and service status is arranged in a network to which said computer peripheral is connected {Column 1, Lines 27-29, wherein this reads over “the user obtains a CD-ROM by purchasing it at a bookshop or by receiving direct distribution from mail order supplier”}.

As for claim 3, URANAKA discloses the computer peripheral sales promoting system according to Claim 1, wherein said network is constituted by the internet {Column 10, Lines 58-60, wherein this reads over “as the network, it is possible to utilize LAN (local area network), WAN (wide area network), Internet, satellite network, etc”}.

As for Claim 4, which has same limitations as in Claim 3, therefore, it is rejected for the similar reasons set forth in Claim 3.

As for claim 5, The computer peripheral sales promoting system according to Claim 1, wherein said computer peripheral is constituted by a data storing apparatus {Column 17, Lines 1-5, wherein this read over “DVD is used as the recording area of the

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media-utilizing information, while other media such as a floppy disk, CD-ROM, et. May be used as portable media, and the recording area of the main unit of media may be used as the recording area of the media-utilizing the information"}.

As for Claim 6, which has same limitations as in Claim 5, therefore, it is rejected for the similar reasons set forth in Claim 5.

As for Claim 7, which has same limitations as in Claim 5, therefore, it is rejected for the similar reasons set forth in Claim 5.

As for Claim 8, which has same limitations as in Claim 5, therefore, it is rejected for the similar reasons set forth in Claim 5.

As for claim 9, URANAKA discloses the computer peripheral sales promoting system according to Claim 5, wherein:

said specifications information includes at least a disk capacity of said data storing apparatus (Element 301); and

said service status detecting means detects a spent disk capacity and a load status of said data storing apparatus as a service status {Column 1, Lines 27-29, wherein this reads over "the CD-ROM thus obtained is placed into a CD-ROM drive of a personal computer at had to display the content of the catalog"}.

As for Claim 10, which has same limitations as in Claim 9, therefore, it is rejected for the similar reasons set forth in Claim 9.

As for claim 11, which has same limitations as in Claim 9, therefore, it is rejected for the similar reasons set forth in Claim 9.

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As for claim 12, As for Claim 8, which has same limitations as in Claim 9, therefore, it is rejected for the similar reasons set forth in Claim 9.

As for claim 13, URANAKA discloses computer peripheral sales promoting method-comprising steps of:

monitoring a specifications information of a sold computer peripheral and a service status of said computer peripheral by a sales promoting terminal arranged in a network to which said computer peripheral or a computer which acts as an upper-level system of said computer peripheral is connected {Column 18, Lines 32-34, wherein this reads over "sales route of the electronic catalog DVD is direct sale from the catalog shopping supplier, and the area where the catalog was sold"};

comparing and discussing said specifications information and service status based on an information obtained by operating said sales promoting terminal {Columns 19-20, Lines 67 & 1, wherein this reads over "compared with the certifying information already stored in the certifying information storage area"};

and suggesting a purchase plan for expansion, upgrading, functional extension, etc. of said computer peripheral based on said user information {Column 1, Lines 46-48, wherein this reads over "it may take some time until changes of price or specification, or addition of new products will be included in the catalog"}.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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I. U.S. Patent:

- 1) U.S. Patent No. 5,987,434 (LIBMAN) is cited to teach usage of client information to automatically select and present financial products appropriate for the client,
- 2) U.S. Patent No. 6,658,586 (LEVI) is cited to teach service with an operations center in order to provide monitoring and tracking services for a plurality of devices, and
- 3) U.S. Patent No. 6,810,401 (THOMPSON ET AL.) is cited to teach the configuration system (and method) for facilitating the configuration of desired products, services, or other assemblages that require users to gather and assimilate disparate knowledge of makes, models, types and etc.

II. Foreign Patent:

- 1) WO 91/07715 (SAMREUS, PHILIP N.) is cited to teach data entry book with sheet identification.

III. Non-Patent Literature:

- 1) HAMAMATSU CITY, Shizuoka, "Yamaha Launches New Multimedia Speaker System for PCs", Business Wire, June 8, 1991, Page 1.
- 2) Rahman, Shukor A, "Local companies gain from CeBIT", New Straits Times, Kuala Lumpur, March 17, 1997, Page 10.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang G. Thai whose telephone number is (703) 305-0553. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
12-21-2004



DENNIS RUHL
PRIMARY EXAMINER